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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/847,085  
Filing Date: May 02, 2001  
Appellant(s): CROMER ET AL.

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JAMES E. BOICE  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/3/06 appealing from the Office action mailed 4/26/06.

**(1) Real Party of Interest**

A statement identifying the real party in interest is contained in the brief. The real party of interest is International Business Machines Corporation(IBM).

**(2) Related Appeals and Interferences**

This is in response to the appeal brief filed 7/3/06 appealing from the Office action mailed 4/26/06. The party of interest, IBM, has stated in the brief that there are no known appeals or interferences related to this appeal. The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-3, 5-8, 10-16.

Claims 4, 9 are allowed.

The Appellant stated in the brief that claims 1-16 are rejected by the Examiner in the Final Action dated 4/26/06. In the previous office action dated, 4/26/06, the Examiner objected to claims 4, 9, and 14. Further, the Reply Brief filed 10/2/09, resulted in the Applicant amending claims 4, 9, and 14. In which Claim 14 is now rejected under claim 101 for containing non-statutory subject matter. The Examiner had

rejected all claims under 112 1<sup>st</sup> and 2<sup>nd</sup>, in the previous office action, thus Claims 4, 9, and 14 were rejected under 112 1<sup>st</sup> and second. However, the 112 1<sup>st</sup> and 2<sup>nd</sup> rejections have been withdrawn.

#### **(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

#### **(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

#### **(6) Grounds of Rejection to be reviewed on Appeal**

##### **NEW GROUND(S) OF REJECTION**

###### **Claim Rejections - 35 USC § 101**

###### **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-16 are rejected under 101 for containing non-statutory subject matter. Claims 12-16 claims, "A program product". In the specification on page 11, the Applicant discloses the program can be a non-rewritable storage medium CD-ROM, or a floppy disk, or hard drive. The Applicant also discloses on page 11, the program may be distributed as digital signals over a network. A claim drawn to such as computer readable storage medium that covers both transitory and non-transitory embodiments may be amended to narrow the

claim to cover only statutory embodiments to overcome 101 rejection by adding the limitation non- transitory to the claims, or by removing the non-statutory subject matter from the specification.

## WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The Examiner previously rejected Claims 1-16 under 112 1<sup>st</sup> for enablement. The Appellant has shown in the specification the difference between a configuration password that is entered by a user, and a device password that is stored on the device. Therefore, the 112 1<sup>st</sup> rejection has been withdrawn. Also, the Examiner previously rejected Claims 1-16 under 112 2<sup>nd</sup> for being indefinite. The Examiner has withdrawn the 112 2<sup>nd</sup> rejection, because the Appellant has shown where in disclosure of the "configuration password", and "device password" are described in the specification. The configuration password in the specification is used to change the order of the boot devices, and this can be changed by the user entering the correct configuration password(see pg. 6). The device password is a password that is stored on the device and is used to insure that the proper device is being booted(pg. 7).

## **Claim Rejection Sustained**

The Examiner's rejection of Appellants' Claims 1-3, 7-8, 12-13 under 102(b) as being anticipated by Pearce et al(6,484,308) and Claims 5-6, 10-11, 15-16 under 35 U.S.C. 103(a) as being unpatentable over Pearce et al. are reviewed on Appeal.

## **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

## **(8) Evidence Relied Upon**

6,484,308      Pearce      November 19, 2002

## **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 7-8, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearce(6,484,308). This rejection is set forth in prior Office Action mailed 4/26/06. Rejection is provided below for committee:

### **Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7-8, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearce et al(6,484,308).

3. As per claims 1, 7, Pearce et al. discloses a method in a data processing system for maintaining security during booting of the data processing system(see col. 2, lines 5-10), during a boot process, interrogating a boot device(i.e., hard disk) for password information (see col. 2, lines 13-16); and in response to the boot device supplying password information corresponding to that of a trusted boot device, booting the data processing system utilizing the boot device(see col. 3, lines 38-67), wherein the booting includes booting the data processing system utilizing the

boot device without entry of any of the password information corresponding to that of a trusted boot device by a human user(see col. 3, lines 38-67).

4. As per claims 2, 8, 13, Pearce discloses the password information of the boot device is used which is the manufacturer id, and drive serial number(see col. 3, lines 58-61).

5. As per claim 3, Pearce et al. discloses wherein interrogating the boot device for password information includes startup software interrogating the boot device(see col. 2, lines 13-16).

6. As per claim 7, it is rejected under the same basis as claim 1(see above). Also, Pearce et al. discloses a memory coupled to the processor for communication (see col. 3, lines 23-37), memory includes startup software(see col. 3, lines 35-37).

7. As per claim 12, it is rejected under the same basis as claim 1. Further, claim 12, discloses wherein the startup software causes a data processing system to interrogate the boot device(see col. 2, lines 16-20, col. 3, lines 39-51).

### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-6, 10-11, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al.

10. As per claims 5, 10, 15, Pearce et al. discloses storing a password in non-volatile storage of the data processing system, inherent in Pearce because Pearce discloses a hard disk(see col. 2, lines 16-20); and determining that the boot device has supplied password information corresponding to a trusted boot device(see col. 5, lines 18-26). However, Pearce does not disclose hashing(i.e., masking) password information and comparing the hashed password information with the stored password. It is well-known in the art, to hash password information and compare the hash password information with the stored password; the motivation to hash password information is that hashing provides data integrity, because the hash-value is protected.

11. As per claim 6, Pearce et al. discloses obtaining the password by interrogating the boot device for the password information with a password-protected configuration routine(see col. 2, lines 5-20, col. 3, lines 38-62).

12. As per claim 11, Pearce et al. discloses the startup software including a password protected configuration routine that obtains the password by interrogating the boot device for the password information(see col. 2, lines 16-20).

13. As per claim 16, limitations have already been addressed(see claim 3 and 6).

14. Claims 4, 9, and 14 are objected to as being rejected on base claims. Claims are objected to for the features of, "interrogating the boot devices for password information includes interrogating a boot device for a device password in sequence of priority order".

#### **NEW GROUND(S) OF REJECTION**

15. **Claim Rejections - 35 USC § 101**

**35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 12-16 are rejected under 101 for containing non-statutory subject matter. Claims 12-16 claim, "A program product". In the specification on page 11, the Applicant discloses the program can be a non-rewritable storage medium CD-ROM, or a floppy disk, or hard drive. The Applicant also discloses on page 11, the program may be distributed as digital signals over a network. A claim drawn to such as computer readable storage medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to overcome 101 rejection by adding the limitation non- transitory to the claim, or by removing the non-statutory subject matter from the specification.

**(10) Response to Argument**

Appellant argues that Pearce discloses that the system and method ensure that the drive inserted in a computer system during system resume after the system is placed in a suspend mode is the same drive originally used to boot the computer.

First, the Appellant is correct in that Pearce does disclose ensuring that the drive inserted in a computer system during system resume after the system is placed in a suspend mode is the same drive originally used to boot the computer. Pearce discloses when the computer system resumes from a powered down or suspend state, the SMM software powers on the hard drive and reads the hard drive information from the drive identification information from the drive(see col. 2, lines 28-30). The SMM software compares the drive identification information stored in memory at boot time. If the two sets of drive identification information are not identical, then SMM software powers off the drive and reports to the user that

the drive installed in the computer system is not the expected drive, i.e., is not the drive used to the boot the system(see col. 2, lines 43-47).

However, Pearce also discloses the system management mode(SMM) software during system boot(see fig. 3 sheet 1). The SMM software powers on the hard drive(i.e., boot device) inserted into the hard drive slot, then the SMM software powers on the hard drive, the SMM software reads the drive identification information on the hard drive(see col. 2, lines 13-20). Pearce discloses that the hard drive identification information includes a unique manufacturer identification number and a drive serial number(see col. 2, lines 16-19). Thus, this boot device(i.e., hard drive) is the drive used to boot the data processing system(computer)(see fig. 2 and 3 sheet 1). The password of Pearce is consistent with the Appellant's specification, that discloses the unique device password for the boot device is a combination of the model and serial number of the boot device(see pg. 8, lines 13-25). Thus, Pearce discloses the device password includes a unique manufacturer identification number and a drive serial number(see col. 4, lines 52-55).

Second, the Appellant argues that the Examiner's entire argument hinges on whether a computer system "boot" and "resume" are identical.

As one of ordinary skill in the art, it is well-known in the art that there is a difference between the terms "boot" and "resume". The Examiner did not state in the previous rejection(4/26/06) that these terms were synonymous. Pearce discloses both "booting", and "resume". Pearce discloses booting, because Pearce discloses when the computer system **boots**, SMM software is invoked which powers on the hard drive(see col. 2, lines 13-16). Pearce explicitly states when the computer system boots. Also, Pearce discloses when the computer system boots, the computer system performs a Power On Self Test(POST)(fig. 2-3 sheet 1), then the SMM software is invoked, and powers on the hard drive, and reads the drive identification information(see col. 4, lines 36-51)

Pearce discloses when the computer system resumes from a power down or suspend state, the SMM powers on the hard drive and reads the drive identification (see col. 2, lines 28-33). Thus, Pearce also explicitly states a resume process as well. Thus, entering the suspended state of Pearce is due to a period of inactivity that has elapsed, and thus a suspended state is entered (see col. 5, lines 7-11). During a resume process, the SMM powers on the hard drive in the computer system and reads the identification information(see col. 5, lines 30-36), a determination is made to determine whether the hard drive inserted in the system when the system resumes is the same hard drive that was used to boot the system(see col. 5, lines 14-18). Thus, Pearce clearly makes a distinction between the terms "boot" and "resume".

In light of the preceding response by Examiner, Claims 7 and 12 and all dependent claims are anticipated by Pearce. Claims 7 and 12 are rejected under 35 U.S.C. 102(b) and the rejection is maintained by the Examiner.

## **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

## **(12) Conclusion**

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercises one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

For the above reasons, it is believed that the rejection should be sustained.

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Timothy P Callahan/

Director, Technology Center 2400

Respectively submitted,

/Jenise E. Jackson/

Art Unit 2439

March 8, 2010

Conferees:

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435